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EXAMINER

WU, ALLEN S

ART UNIT PAPER NUMBER

2135

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/837,884

Applicant(s)

MERCHEN, M. RUSSEL

Examiner

Allen S. Wu

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/18/01 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 610 (of fig 6), 910 (of fig 9), 2055, 2060, 2065, 2070, 2075, 2080 (of fig 20). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 1, 4-8, 9, 12-16, 17, 20-24, 26, 28-32, 33, 36-40, 41, 44-48 rejected under 35 U.S.C. 102(e) as being anticipated by DeBry, US Patent 6,385,728.

As per claims, 1, 17, and 33, DeBry discloses means of authorizing electronic data transfer (abstract) comprising:

receiving an authentication request containing a digital certificate from a requesting device via a communication link (506, fig 5 and col 8 ln 50-53)

determining whether the digital certificate is valid (507, fig 5 and col 8 ln 53-63);

creating an authentication response (508, fig 5) denying authentication request when the digital certificate is not valid, or approving the authentication request when the digital certificate is valid (col 8 ln 58-60);

sending the authentication response to the requesting device via the communication link (508, fig 5, col 8 ln 58-65);

storing information about the electronic data transfer, the digital certificate and at least a portion of the authentication response (col 8 ln 6- col 9 ln 4; the user must forward such data to a printer for obtaining the file, thus such information storing is inherent to the teachings of DeBry).

As per claims 2, 18, and 34, DeBry discloses the claimed limitations as described above (see claim 1). DeBry further discloses wherein the

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authentication request and the authentication response are transmitted via encrypted message (secure environment, col 2 ln 34-45 and col 8 ln 40-49).

As per claims 4, 20, and 36, DeBry discloses the claimed limitations as described above (see claim 1 above) and further discloses wherein the authentication response includes a date/time stamp (col 7 ln 28-30).

As per claims 5, 21, and 37, DeBry discloses the claimed limitations as described above (see claim 1 above) and further discloses wherein the digital receipt includes a digital receipt (will call certificate (col 8 ln 50-65).

As per claims 6, 22, and 38, DeBry discloses the claimed limitations as described above (see claim 5 above) and further discloses wherein the digital receipt includes an identification of an originator of the electronic data transfer (user ID, col 7 ln 37-38).

As per claims 7, 23, and 39, As per claims 4, 20, and 36, DeBry discloses the claimed limitations as described above (see claim 1 above) and further discloses wherein the digital receipt includes an identification of a recipient of the electronic data transfer (printer ID, col 7 ln 39-40).

As per claims 8, 24, and 40, DeBry discloses the claimed limitations as described above (see claim 1 above) and further discloses wherein the information about the electronic data transfer includes an electronic document (a document printed, col 5 ln 51-53).

As per claims, 9, 25, and 41, DeBry discloses means of authorizing electronic data transfer (abstract) comprising:

receiving an authentication request containing a digital certificate and information about the electronic data transfer from a requesting device via a communication link (506, fig 5 and col 8 ln 50-53; such information about the electronic data transfer must be included to specify the correct document to be obtained)

determining whether the digital certificate is valid (507, fig 5 and col 8 ln 53-63);

creating an authentication response (508, fig 5) denying authentication request when the digital certificate is not valid, or approving the authentication request when the digital certificate is valid (col 8 ln 58-60);

sending the authentication response to the requesting device via the communication link (508, fig 5, col 8 ln 58-65);

creating a digital receipt for the electronic data transfer when the digital certificate is valid (will call certificate; col 8 ln 58-60)

storing information about the electronic data transfer, the digital certificate and at least a portion of the authentication response (col 8 ln 6- col 9 ln 4; the user must forward such data to a printer for obtaining the file, thus such information storing is inherent to the teachings of DeBry).

Claims 10, 26, and 42, recite similar limitations as described in claims 2, 18, and 34 as described above and are rejected under the same rationale.

Claims 12, 28, and 44, recite similar limitations as described in claims 4, 20, and 36 as described above and are rejected under the same rationale.

Claims 13, 29, and 45, recite similar limitations as described in claims 6, 22, and 38 as described above and are rejected under the same rationale.

Claims 14, 30, and 46, recite similar limitations as described in claims 7, 23, and 39 as described above and are rejected under the same rationale.

As per claims 15, 31, and 47, DeBry discloses the claimed limitations as described above (see claim 9). As for where in the digital receipt includes an action taken relating to the electronic transfer, DeBry further discloses that such a receipt is used a means of validating printing of a document (col 7 ln 7-20 and col 8 ln 58-65), and thus an action (validation of printing) taken relating to the electronic transfer.

Claims 16, 32, and 48, recite similar limitations as described in claims 8, 24, and 40 as described above and are rejected under the same rationale.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 11, 19, 27, 35, and 43, are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry, US Patent 6,385,728.

As per claims, 3, 19, and 35, DeBry discloses the claimed limitations as described above (see claim 1). DeBry does not explicitly teach wherein step of determining further comprising sending a validation request for the digital certificate to a validation authority; and receiving a validation response from the validation authority indicating whether or not the digital certificate is valid.

However, DeBry discloses an alternative embodiment comprising of determining whether a digital certificate is valid comprising; sending a validation request for the digital certificate to a validation authority (col 9 ln 15-20). As for receiving a validation response from the validation authority indicating whether or not the digital certificate is valid, DeBry further discloses that the server using a validation authority to authenticate the certificate (col 9 ln 15-19). Such a validation response is inherent to such network communications involving authentication of a digital certificate by a validation authority.

Both the print server and file server of DeBry are servers connected to a user through the network able to determine validity of digital certificates. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the validation means of the print server within the file server of DeBry because it would have created a more secure means of validation from a trusted third party.

Claims 11, 27, and 43 recite the same limitations as described in claims 3, 19, and 35 above and are rejected under the same rationale.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Eschelbeck et al, US Patent 6,611,869, discloses use of digital certificates for authorization of electronic transfers.

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Tycksen, Jr. et al, US Patent 6,189,097, discloses a digital certificate for use with electronic transaction.

Francoeur et al, US Publication 2002/0065695, discloses an electronic transaction involving use of digital receipts.

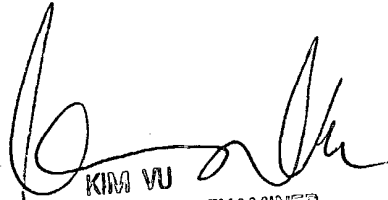
Berman, US Publication 2002/0052851, discloses a means of electronic transaction using digital certificates and encryption.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen S. Wu whose telephone number is (571) 272-3860. The examiner can normally be reached on Monday-Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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